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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,422	08/15/2001	Peter Ar-Fu Lam	DISPMT1	1550
7590	03/11/2010	Peter Ar-Fu Lam 20104 Wayne Ave. Torrance, CA 90503	EXAMINER BUCHANAN, CHRISTOPHER R	
			ART UNIT 3627	PAPER NUMBER
			MAIL DATE 03/11/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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MAR 11 2010

Peter Ar-Fu Lam
20104 Wayne Avenue
Torrance, CA 90503

In re Application of
Peter Ar-Fu Lam
Application No. 09/930,422
Filed: August 15, 2001
For: BODY PROFILE CODING METHOD
AND APPARATUS USEFUL FOR ASSISTING
USERS TO SELECT WEARING APPAREL

DECISION ON PETITION
UNDER 37 CFR §1.181

This is a decision on applicant's communication denominated "Petition to Director - according to 37 CFR 1.181" filed February 19, 2010, which will be treated as a petition requesting supervisory review.

The petition is **GRANTED-IN-PART**.

The petition filed February 19, 2010 consists of two parts. In part A, petitioner requests "an office action that honors the right of the applicant to have the terms of claim 40 to be interpreted according to MPEP 2111.01, MPEP 2011.01 III and MPEP 2112.02." In part B, petitioner requests that the examiner provide "supporting prior art or an affidavit under 37 CFR 1.107(b) about the level of skill to take an office notice stated in lieu of a supporting prior art."

Relevant Rules and Procedures

37 CFR § 1.104 Nature of examination.

- (b) Completeness of examiner 's action . The examiner 's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.
- (c) Rejection of claims.
 - (1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. **The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.**

MPEP 1201 [R-3] Introduction

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a *>substantive< nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. **Where the differences of opinion concern the denial of patent claims because of prior art or **>other patentability issues<, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute >(35 U.S.C. 134)<.**

MPEP 2144.03 [R-6] Reliance on Common Knowledge in the Art or “Well Known” Prior Art

...
C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 (“[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.”). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. **If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.** See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

Discussion

As concerns part A, petitioner alleges that after repeated requests, with respect to claim 40, the examiner has repeatedly failed to clarify how the "claim limitations are interpreted and found in the prima facie prior art Spackova." Petitioner "requests an office action that honors the right of the applicant to have the terms of claim 40 to be interpreted according to MPEP 2111.01, MPEP 2111.01 III and MPEP 2112.02 as recited herein for constructing the claim limitations, then for the differences between constructed claim limitations and the prior art to be compared as directed by the Graham inquiry, and then the comparison process, reasons and results to be comprehensively expressed in an office action, clarifying and answering all the ambiguous area raised by the applicant in accordance to 37 CFR 1.104(b) and MPEP 707.07."

37 CFR 1.104(b) requires that "the examiner's action will be complete as to all matters;" however, contrary to petitioner's assertion, there is no requirement that there be an "explanation how every claim limitation, one by one is interpreted, and how the corresponding claim interpretation is exactly found in the figure and element numbers of the drawings, or located in the wording description in column and line numbers of the prior art specification." As set forth in 37 CFR 1.104(c)(2), in rejecting the claims under prior art, "the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

A review of the final Office action mailed December 22, 2009 indicates that claim 40 is rejected under 35 USC 103(a) as being obvious over Spackova in view of Aisaka. In regards to petitioner's request for an explanation of how the claim interpretations are "exactly found in the figure and element numbers of the drawings, or located in the wording description in column and line numbers of the prior art specification," beginning on page 4 of the Office action, the examiner has set forth the scope and content of the prior art (i.e., the various claim limitations that Spackova discloses). The examiner then ascertains the differences between the claimed invention and the prior art (see bottom of page 4). The examiner then resolves the level of ordinary skill in the pertinent art for the obvious combination or modification (beginning at the first full paragraph on page 5). The test for obviousness is not whether the features of the references may be bodily incorporated into the other to produce the claimed subject matter but simply what the references make obvious to one of ordinary skill in the art. *In re Bozek*, 163 USPQ 545, (CCPA 1969); *In re Richman* 165 USPQ 509, (CCPA 1970); *In re Beckum*, 169 USPQ 47 (CCPA 1971); *In re Sneed*, 710 F.2d 1544, 218 USPQ 385.

Accordingly the examiner has provided a complete action in accordance with 37 CFR 1.104. As set forth in MPEP 1201, where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and thus are not petitionable. Therefore, petitioner's request for "an office action that honors the right of the applicant to have the terms of claim 40 to be interpreted according to MPEP 2111.01, MPEP 2111.01 III and MPEP 2112.02 as recited herein for constructing the claim limitations, then for the differences between constructed claim limitations and the prior art to be compared as directed by the Graham inquiry, and then the comparison process, reasons and results to be comprehensively expressed in an office action, clarifying and answering all the ambiguous area raised by the applicant in accordance to 37 CFR 1.104(b) and MPEP 707.07" is **dismissed**.

As concerns part B of the petition, petitioner requests supporting prior art for the examiner's holding of official notice. As the holding of official notice is directed to a grounds of rejection, it is not a petitionable matter. However, part B of the petition will be treated as a request for supervisory review of the final rejection and a petition to withdraw the finality of the December 22, 2009 Office action.

In the non-final office action mailed July 30, 2009, the examiner took official notice that "the features of a compressed body profile code is well-known and commonly used in the art" (claim 40) and that "data compression, decompression and manipulation are well-known in the art" (claim 52). In the response filed October 30, 2009, applicant challenged the examiner's factual assertion. In the final rejection mailed December 22, 2009, the examiner repeated the official notice, but failed to provide adequate evidence. Furthermore, the examiner stated that "a proper response to rejections made using **official notice** or design choice require the applicant to submit reasoned arguments that explain how the rejection is invalid and describe the novelty of, purpose of, and problems solved by the invention along with evidence supporting these arguments" (emphasis added).

MPEP 2144.03 clearly sets forth that to adequately traverse an examiner's official notice, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. If applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the examiner must support the finding with adequate evidence. If applicant's traverse is inadequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because the traverse was inadequate. If the traverse is inadequate, the examiner should include an explanation as to why it was inadequate.

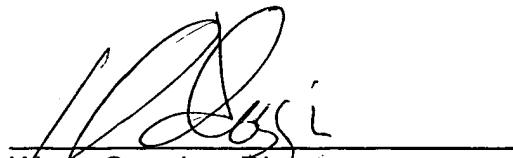
Applicant has traversed the examiner's official notice. It was improper for the examiner to repeat the official notice without providing adequate evidence. Additionally, it was also improper to require the applicant to submit "reasoned arguments that explain how

the rejection is invalid and describe the novelty of, purpose of, and problems solved by the invention along with evidence supporting these arguments." Accordingly, the finality of the December 22, 2009 Office action is withdrawn.

The application will be returned to the examiner for further action commensurate with this decision.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181."

Questions concerning this decision should be referred to Teri Luu, Quality Assurance Specialist, at (571) 272-7045.



Wynn Coggins, Director
Patent Technology Center 3600
Telephone No.: (571) 272-5350

WG/tl: 03/09/10

